

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSIE HOLLAND

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Appeal No. 2002-1585  
Application No. 09/248,153

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ON BRIEF

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Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a greeting card. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The single prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Kaiser	5,370,421	Dec. 6, 1994
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Claims 1-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kaiser.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 10) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 9) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence

corresponding to the pre-colored drawing. The objective of the invention is to provide a greeting card in which instructions are provided for coloring the line drawing by virtue of the presence of the corresponding pre-colored drawing. Claim 1 reads as follows:

A greeting card, which comprises:

a first surface containing a pre-colored drawing or photograph; and

a second surface composed of colorable material and containing a line drawing corresponding to at least a portion of the pre-colored drawing and having segments into which colors can be placed.

Claim 1 stands rejected as being unpatentable over Kaiser. In the course of arriving at this decision, the examiner has taken the position that the printed matter is not related to the substrate “in a new or unobvious way,” and therefore cannot be used to distinguish the claimed subject matter over the prior art (Answer, page 3). The guidance provided by our reviewing court on this issue is that differences between the invention and the prior art cannot be ignored merely because they reside in the content of printed matter, and the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.<sup>1</sup> It is our opinion that, viewing the claims as a whole, a new and unobvious functional relationship is defined between the printed matter and the substrate in the present case

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printed matter can be excised from the appellant's claims when considering their patentability.

With regard to Kaiser, we first observe that this reference was described on page 2 of the appellant's specification as the prior art over which the invention is considered to be an improvement, with the appellant explaining that while Kaiser disclosed line drawings on a colorable substrate, it failed to "indicate" that the greeting card contained a corresponding pre-colored drawing. Notwithstanding the contention that the printed matter can be ignored, the examiner has taken the position that the pre-colored first surface recited in claim 1 finds correspondence in Figure 4 of Kaiser in that "the leftmost surface [of the Kaiser card] with the 'Happy' and the heart on it - the drawing is considered to be pre-colored since these elements are in black ink." The examiner further opines that the second surface in Kaiser is comprised of colorable material and contains a line drawing corresponding to at least a portion of the pre-colored drawing because "the heart on the second surface corresponds to the heart on the first surface."

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie

227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is true that an objective of the Kaiser patent is to provide a greeting card that can be colored (column 1). However, all of the drawings disclosed by Kaiser are line drawings; none are shown or described as being pre-colored. The appellant has explained on page 5 of the specification that the pre-colored drawing or photograph suggests the colors to be applied to "segments 14 of the line drawing 5," that is, it is not the lines that are pre-colored, but segments of the drawing. It therefore is our view that one of ordinary skill in the art would not have considered the Kaiser line drawings to be "pre-colored" in the manner required by the appellant's claims. Since we have concluded above that the printed matter must be considered when evaluating the patentability of the claims, with regard to claim 1, Kaiser fails to disclose or teach "a first surface having a pre-colored drawing or photograph."

teaching, suggestion or incentive in either which would have led one of ordinary skill in the art to modify the Kaiser invention by pre-coloring one of the corresponding line drawings, other than that which is obtained by first viewing the appellant's disclosure, which is not a proper basis for a rejection under 35 U.S.C. § 103.<sup>2</sup>

Kaiser thus fails to establish a prima facie case of obviousness with regard to the subject matter recited in independent claim 1, and we will not sustain the rejection of claim 1 or, it follows, of claims 2-5, which depend therefrom.

The limitation regarding the pre-colored drawing or photograph also is recited in independent claims 6, 11 and 16, and on the basis of the same reasoning we therefore will not sustain the rejection of these claims plus dependent claims 7-10, 12-15, and 17-20.

#### CONCLUSION

The rejection of claims 1-20 as being unpatentable over Kaiser is not sustained.

The decision of the examiner is reversed.

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NEAL E. ABRAMS  
Administrative Patent Judge

CHARLES E. FRANKFORT  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

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